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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Kenneth Lawrence Accardi et al.

Serial No.: 09/199,506

Filed: November 25, 1998

For: MEDICAL DIAGNOSTIC SYSTEM SERVICE METHOD AND APPARATUS

Group Art Unit: 2152

Examiner: Jaroenchonwanit, B.

Atty. Docket: GEMS:0029/YOD
15-SV-4769

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August 18, 2003 — Date

Lynda Howell

REPLY BRIEF

This is in reply to the Examiner's Answer mailed on June 18, 2003.

Appellants first note that the representative for the Appellants is not Helen Tinsley, as indicated in the Examiner's Answer, but the undersigned, Mr. Patrick S. Yoder.

Appellants also note that the Examiner's indication of the status of the claims is correct. That is, a further non-final rejection was formulated by the Examiner based on 35 U.S.C. §102(f), and a response to that rejection was advanced by the Appellants, with the present Appeal being reinstated.

The Examiner's Brief addressed the various issues on appeal formulated in the Appeal Brief in an order different than those issues were addressed in the Appeal Brief.

The present Reply Brief takes up these issues in the order in which they were enumerated in the Appeal Brief.

ISSUE NO. 1.

All of the independent claims presently pending in the application were rejected under 35 U.S.C. §103(a) as being obvious over Jago et al. in view of Friz et al. In responding to the points made both in various responses filed by the Appellants and in the Appeal Brief, the Examiner turned to specific passages of these two references in support of his position. In general, it must be borne in mind that all of the independent claims pending and under appeal relate to "service requests" (see claims 1, 8, 22 and 36), or "service messages" (see claim 29), or "serviceable operational conditions" in connection with diagnostic stations of different medical modalities (see claim 15). In addressing the issue of service requests, the Examiner continues to point to a passage in Jago et al. at col. 8, lines 15-19. The Examiner assumes that this passage teaches "the electronic messaging system of an ultrasound system automatically catching performance information of the ultrasound and sending to its manufacturer." See Examiner's Answer, page 15. The passage actually reads

> The electronic messaging system can be configured to automatically capture system information when a problem occurs, such as the system error log, status and configuration, and to automatically send the error log to the manufacturer or repairman at the time of the problem.

Jago et al., Col. 8, lines 15-19.

Even if the Examiner's characterization of the passage were correct, the argument misses the point. As discussed throughout the present application, and in arguments advanced by the Appellants repeatedly, existing systems that automatically capture information and transmit the information for remote processing do not permit a service request to be generated for operational servicing of the equipment. Specifically, in the area of medical diagnostic systems, prior to the present invention, no system was known

to provide such facilities. Certainly, Jago et al. do not teach formulating a service request.

On this same point, the Examiner further relies on Friz et al. A passage repeatedly relied upon by the Examiner is found at col. 3, lines 23-45, and another at col. 11, lines 30-20 of the Friz et al. reference. The Examiner characterizes these passages as teaching "a software functioning as performance monitoring system that included "[sic] automatically initiating server request [sic] to remote locations." In fact, the passages recite:

> The performance monitoring system and method preferably are realized and implemented, respectively, by a software system. The software system can be implemented on-site with a laser imager, but preferably is configured to automatically monitor the performance of one or more remotely located laser images. The software system can be configured to *periodically poll* the remotely located laser images over a period of time to generate image quality control reports, eliminating the need for manual generation of such reports by a technician.
>
> The software system also can be configured to monitor modality usage, imaging media usage, and the occurrence of errors for each laser imager, and to automatically generate usage reports and error reports. In addition, the software system can be configured to automatically send the reports to users of the laser imagers, automatically initiate an order to send additional imaging media, and automatically initiate a request for dispatch of a service technician in response to an error condition. As a further advantage, the software system can be configured to generate the image quality control reports in conformance with standards of regulatory agencies or other organizations regulating usage of laser images.

Friz et al., Col. 3, lines 23-45 (emphasis added).

> The performance monitoring system 46 automatically monitors one or more remotely located laser imagers 14_1-14_N over a period of time to generate image quality control reports, eliminating the need for manual generation of such reports by a technician. The performance monitoring system46 also monitors modality usage, imaging media usage, and the occurrence of errors for each laser imager 14_1-14_N, and automatically generates usage reports and error reports. In addition, *system 46 is*

> *capable of* automatically sending the reports to users of laser imagers 14_1-14_N, automatically initiating an order to send additional imaging media 22, and automatically initiating a request for dispatch of a service technician in response to an error condition. As a further advantage, system 46 is capable of generating the image quality control reports in conformance with standards of regulatory agencies or other organizations regulating usage of laser imagers 14_1-14_N.

Friz et al., Col. 11, lines 3-20 (emphasis added).

As with Jago et al., the teachings of Friz et al. do not extend to the formulation of a service request at a diagnostic apparatus. Quite the contrary, in the first passage, Friz et al. mention *polling* by a *remote* monitoring system. This is simply confirmed in the second passage, in which the performance monitoring system 46, which is *remote* from the serviced equipment (laser imagers 14_1-14_N) can collect information, generate reports, initiate service dispatches, and so forth. The teachings of Friz et al., in fact, represent the prior art immediately preceding the present invention. That is, remote servicing could be accomplished by remote monitoring, but service requests *at the diagnostic stations* was not performed in response to service requests formulated at the diagnostic stations. This point is a key, and is supported concretely by various terms in each of the pending independent claims.

Appellants simply note that the Examiner has relied upon these same passages throughout the various arguments made in response to the Appellants' Appeal Brief.

In summary, the Appellants would rely upon the arguments advanced in the Appeal Brief, and particularly in view of the fact that neither of the primary references teaches or suggests originating service requests at medical diagnostic apparatus or diagnostic systems.

ISSUE NO. 2

Issue No. 2 relates to the patentability of certain dependent claims, namely claims 7, 14 and 24. Appellants reiterate the arguments brought out throughout prosecution and in the Appeal Brief, and believe that each of these dependent claims is patentable, particularly in view of its dependence from an allowable base claim.

ISSUE NO. 3

All of the pending claims stand rejected under the judicially created doctrine of non-statutory double-patenting in view of Derzay et al. Appellants first note that at the time the present application and the Derzay et al. application were filed, considerable effort was made to isolate and designate separate inventions in the claims. This effort was made to avoid unnecessarily dividing the applications and paying repeatedly for filings for what were considered to be separate inventions. It is of course not surprising that the applications have identical detailed descriptions. Indeed, they describe aspects of the same system, a system that embodies several different inventions. Appellants still firmly believe that the present claims are fully patentable, and are not obvious in view of the claims made in the Derzay et al. patent.

ISSUE NO. 4

The Examiner rejected all of the pending claims as unpatentable under 35 U.S.C. §102(f), stating that the Appellants did not actually invent the claimed subject matter. Essentially, the Examiner argues that, because the detailed descriptions contained in the present application and in the Derzay et al. patent are essentially identical, the present Appellants did not invent the claimed subject matter. Again, as clearly pointed out in the Appellants' Brief, after considerable effort to identify the appropriate inventors, all of the present inventors executed a sworn Declaration indicating that they believed they were the first and true inventors of the presently claimed subject matter.

As provided in MPEP § 2137,

> Where there is a published article identifying the authorship (MPEP §715.01(c)) or a patent identifying the inventorship (MPEP §715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect with the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent so as to justify a rejection under 35 U.S.C. 102(f).

Appellants further note that the MPEP specifically recognizes that the executors of an Oath or Declaration under 37 C.F.R. 1.63 are presumed to be the inventors. See MPEP §2137.01. In the present case, the inventors, while working hand-in-hand with other members of a design team, developed parallel inventions that were incorporated into a single system, they did not derive the claimed invention from that of their colleagues. Appellants therefore resubmit that the rejection under 35 U.S.C. §102(f) is improper and the Board should overturn the rejection.

In conclusion, it is believed that all of the claims pending under appeal are fully patentable for all of the reasons summarized above. Appellants renew their request for a favorable decision of the Board.

Respectfully submitted,

Date: 8/18/2003

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